

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Caine et al.)
)
For: A Keypad and Method for)
Detecting the Selection of One of)
a Plurality of Key Inputs)
Associated with a Single)
Keystroke)
)
Serial No.: 10/769,258)
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Filed: January 30, 2004)
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Examiner: Piziali, J.)
)
Art Unit: 2629)

Pre-Appeal Brief Request for Review

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants hereby request review of the final rejection in the above-identified application. No amendments are being filed with this request. The present request is being filed in conjunction with a notice of appeal. The review is being requested for the reasons stated below, which frames the issue to be considered as part of the pre-appeal review process.

The Examiner continues to reject claims 1-22. More specifically, the Examiner has rejected claims 1-22 under 35 USC §112, first paragraph as failing to comply with the written description requirement (independent claims 1, 18 and 19), or as being dependent upon a claim that fails to comply with the written description requirement (dependent claims 2-17 and 20-22). The Examiner has further rejected claims 1-17 under 35 USC §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (independent claim 1), or as being dependent upon a claim that is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (dependent claims 2-17). The Examiner still further has

rejected claims 1-3, 5-8 and 11-20 under 35 USC §102(b) as being anticipated by Swanson, US Patent No. 6,541,715; and further yet has rejected claims 4, 9, 10, 21 and 22 under 35 USC §103(a) as being unpatentable over Swanson, '715, in view of Kato et al., US Patent No. 6,356,258, and rejected claims 12-14 under 35 USC §103(a) as being unpatentable over Swanson, '715, in view of Yu et al., US Patent No. 5,852,414.

However contrary to the Examiner's assertions, the specification satisfies the written description requirement, so as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. Furthermore, contrary to the Examiner's assertions, the claims particularly point out and distinctly claim the subject matter, which the applicants regard as their invention. Further yet, contrary to the Examiner's assertions, the relied upon references fail to make known or obvious each and every feature of any of the claims, and therefore cannot be said to make known or obvious any of the respective claims.

In alleging that the specification fails to comply with the written description requirement, the Examiner has appeared to focus on the claimed relationship of the switches and the portion of the key contact surfaces associated with a particular secondary input selection, as being positioned in direct vertical alignment. The Examiner alleges that the specification fails to provide support for such a feature. However contrary to the Examiner's assertions, FIG. 2 and portions of the related description provide support for just such a feature. More specifically, FIG. 2 highlights the outline of a key 102 (i.e. the corresponding layout of the same), and an exemplary circuit schematic, which includes multiple switches 122, each of which is located at a respective vertex of the key 102 (see page 5, lines 21-22 of the present specification), which is engaged when the corresponding one of the vertices is depressed (see page 5, lines 22-24). Placement of the respective switches at the vertex of the key gives the user a discrete location to engage, if and when it is desired to indicate a secondary input selection (see page 6, lines 11-12), such that it would be clear to one skilled in the art, that the applicant possessed the feature of the switches and the portion of the key contact surfaces associated with a particular secondary input selection, as being positioned in direct vertical alignment, when taken from the frame of reference noted in the claims where the plurality of switches are positioned and arranged horizontally relative to one another.

While the Examiner may be seeking a showing where the exact language can be found in the specification as originally filed, such a requirement is misplaced, as there is no such requirement.

As articulated by the Federal Circuit, the test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at the time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). It is well settled, that a determination as to whether the originally filed disclosure of the application reasonably conveys to the artisan an indication that the inventor had possession of the claimed subject matter, does not require that the claimed subject matter be described identically. Precisely how close the original description must come in order to comply with the description requirement must be determined on a case-by-case basis. In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984) (emphasis added).

In the present instance, while the claimed subject matter is not described identically, there is no such requirement. Further, in view of at least the portions of the application noted above, one skilled in the art would understand that the inventors had possession of the later claimed subject matter, at the time the application was originally filed. Consequently, the corresponding rejection relative to independent claims 1, 18 and 19, and the claims which depend therefrom, should be withdrawn.

Furthermore, contrary to the Examiner's assertion, the claims as presently articulated particularly point out and distinctly claim the subject matter which applicants regard as the invention. In raising an objection with respect to claim 1 (and indirectly the claims which depend therefrom), the Examiner has appeared to focus on a lack of an antecedent basis for the portion of the contact surface. However the claimed portion(s) of the contact surface are inherent relative to the contact surface of the key, especially where multiple associated switches corresponding to separate secondary input selections can be separately engaged dependent upon the manner in which the contact surface is engaged and the key is actuated, as otherwise provided in the claims. As a result, the inherent features do not need to be separately positively recited, and a portion of the contact surface would be understood to be associated with less than all of the contact surface and more particularly to the part that corresponds to a secondary input

selection (relative to the portion of the claim in question and the corresponding context). The applicant would allege that one skilled in the art would understand the metes and bounds of the claims, as presently worded, so as to be understood as being clear. Consequently, the Examiner's assertion that the claims fail to particularly point out and distinctly claim the subject matter can not be supported, when viewed from the perspective of one skilled in the art, and the entirety and complete context of any one of the claims.

Relative to the alleged anticipation of at least independent claims 1, 18 and 19, which the Examiner alleges are anticipated by Swanson, '715, contrary to the Examiner's assertion Swanson, '715, fails to make known each and every feature of claims 1, 18 and 19, and indirectly any of the claims, which depend therefrom. More specifically, Swanson, '715, fails to make known or obvious a feature where the corresponding one of the plurality of switches associated with each of the secondary input selections as being in direct vertical alignment with the portion of the contact surface associated with the particular secondary input selection (claim 1); a feature where the portion of the contact surface associated with each of the secondary characters is in a direct vertical alignment with the associated contact (claim 18); and/or a feature where each switch is associated with and directly vertically aligned with a corresponding one of the three or more secondary input selections (claim 19).

In Swanson, '715, there is no direct vertical alignment between the portion of the contact surface associated with a secondary input and the associated switch. Alternatively, the keys are engaged in a manner in which the associated switches are located opposite the portion of the contact surface along a diagonal. More specifically, looking down at the key from a perspective illustrated in FIG. 2 of the reference, the lateral facet 11, located in the upper left hand portion of the illustrated key is associated with switch 22, which as can be seen in FIG. 3 is directly vertically aligned with lateral facet 13 (see col. 3, lines 38-51) and hence located more proximate to the lower right hand portion of the illustrated key. The noted paragraph at col. 3, lines 38-51 of the published reference further associates each of the other three lateral facets with a corresponding switch that, similarly, is not directly vertically aligned, where facet 12 is associated with switch 23, facet 13 is associated with switch 24 (cannot be seen – obstructed), and facet 14 with switch 21 (none of which are directly vertically aligned). Consequently, contrary to the Examiner's assertion each and every feature of the claims has not been shown to be made known or obvious, and therefore the rejection of independent claims 1, 18 and 19, as

well as any of the dependent claims 2-17 and 20-22, can not be maintained. Relative to claims 4, 9, 10, 12-14, 21 and 22, the further relied upon references, in the rejection of the same, fail to account for the above noted deficiencies. As a result, the dependent claims rejected as being obvious in view of a combination of references, similarly fail to make known or obvious each and every feature of the claims.

In view of the above remarks, the applicants would respectfully request that the Examiner's final rejection of the claims be withdrawn, as failing to make known or obvious each and every feature of the claims, and as being improperly rejected as failing to comply with the written description requirement, and/or as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Respectfully submitted,

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